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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Markus Oles

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EXAMINER

MATZEK, MATTHEW D

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

10/16/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/506,813	<b>Applicant(s)</b> OLES ET AL.	
	<b>Examiner</b> MATTHEW D. MATZEK	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-23 and 25-34 is/are pending in the application.
- 4a) Of the above claim(s) 6-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5 and 25-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/1/2009 has been entered.

***Response to Amendment***

2. The amendment dated 7/1/2009 has been fully considered and entered into the Record. Claims 1, 4, 5, 25, 26 and 28-34 have been amended. The amended claims contain no new matter. Claims 1 and 4-34 are currently pending. Claims 6-23 remain withdrawn from consideration and claims 1, 4, 5 and 25-34 are currently active. The previous rejection made in view of Henkel has been withdrawn as it fails to establish the use of silica for hydrophilicizing purposes.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 4, 5 and 25-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Soane et al. (US 2003/0013369 A1) in view of the Handbook of Fillers-A Definitive User's Guide and Databook, "The Handbook".

a. Soane et al. disclose nanoparticle-based treatments for textiles (title). The nanoparticles preferably have a size ranging from about 1 nm to 1 micron [0080]. The reactive nanoparticle may be made from a variety of materials including hydrophilic materials [0080]. Silica particles are used as sunblocking agents, [0112] but may also have hydrophilic properties. The nanoparticle consists of the payload, in this case silica, and is surrounded by a polymer shell or matrix. The surrounding shell or matrix is in turn reactive with fibers, yarns, fabrics or webs and allows the nanoparticle to become anchored to the surface of textile [0005]. The nanoparticles then become fixative particles. The surrounding shell or matrix serves as the claimed carrier layer in that it facilitates the bonding of the payload to the surface of the textile. Examples I and II demonstrate that while the payload is embedded or entrapped in within the polymeric encapsulator, it is also capable of performing its desired function [0101]. The embedded nanoparticles may result from either solvation or a swelling process [0094]. Functional groups of the nanoparticle shell react with the coated textile or web and the textile is then dried and the polymeric encapsulator may then be cured [0094].

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- b. Soane et al. teach the use of generic silica, but fail to teach the use of fumed silica for the purpose of making the treated surface hydrophilic.
- c. The Handbook provides background information about the various forms of silica filler and how they are formed (page 131). Silica is commonly used in industry due to chemical inertness and durability (page 131). Fumed silica is amorphous in nature and possesses benefits over its crystalline form (page 134). It is used as filler for a number of reasons including thixotropy, sag resistance, particle suspension, emulsifiability, reinforcement, gloss reduction, flow enhancement of powders, anti-caking, anti-slip, anti-blocking, etc. The many benefits offered by this filler allow fumed silica to be used in many industries (page 137). The reference also discloses the properties of fumed silica such as its primary particle size ranging from 5-40 nm and surface area of 50-400 m<sup>2</sup>/g (page 132).
- d. Soane et al. and the Handbook are from the same field of endeavor (i.e. nanoparticle treatments).
- e. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have used the fumed silica as disclosed in the Handbook in the invention of Soane et al. with the motivation of providing improved performance due to the inherent properties of fumed silica and the amount of surface area available as disclosed. Soane et al. and the Handbook fail to explicitly state that their silica particles would act as a hydrophilicizing agent, but their combination does render the claimed invention obvious. The applied combination of references would necessarily yield the claimed hydrophilic surface.

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- f. Claim 25 is met as textile of Soane et al. may be used as a cleaning textile.
- g. The nanoparticles may be applied to a textile via methods known in the art such as soaking, spraying, dipping, fluid-flow, padding and the like [0094]. The concentration of the nanoparticles present in the solution used to treat the textile depends on the amount of nanoparticles deposition desired [0096]. In the same way the percentage of the surface composed of the nanoparticles is a result-effective variable affecting the function of the payload located in the nanoparticle has on the surface. Consequently, absent a clear and convincing showing of unexpected results demonstrating the criticality of the claimed ratio, it would have been obvious to one of ordinary skill in the art to optimize this result-effective variable by routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).
- h. Soane et al. fail to explicitly disclose that the polymeric shell of the nanoparticle is melted. Claim 32 is rejected as in order to coat the payload nanoparticles with the polymer shell it is covered with molten polymer. Therefore, the polymer coated nanoparticles applied to the surface of the textile the carrier layer would necessarily comprise melted fixative as the shell at one time was molten. Furthermore, it would have been obvious to one of ordinary skill in the art to have heated the polymer to the point of at least partial melt because the melted polymer would offer additional surface area for bonding over an unmelted shell. The additional surface area would provide an increase in the bond strength over the single point covalent bonding available without any melting of the polymer.

***Double Patenting***

4. Claims 1, 5, 25-27 and 29-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 48 of copending Application No. 11/249315. Although the conflicting claims are not identical, they are not patentably distinct from each other because the applied application fails to recognize the hydrophilic properties of the fumed silica, but hydrophilicity would be provided by the fumed silica due to its inherent properties. The percentage of the surface composed of the nanoparticles is a result-effective variable affecting the function of the payload located in the nanoparticle has on the surface. Consequently, absent a clear and convincing showing of unexpected results demonstrating the criticality of the claimed ratio, it would have been obvious to one of ordinary skill in the art to optimize this result-effective variable by routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1, 5 and 29-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3 and 7 of copending Application No. 10/506604. Although the conflicting claims are not identical, they are not patentably distinct from each other because the applied application fails to recognize the hydrophilic properties of the fumed silica, but hydrophilicity would be provided by the fumed silica due to its inherent properties. The percentage of the surface composed of the nanoparticles is a result-effective variable affecting the function of the payload located in the nanoparticle has on the surface. Consequently, absent a clear and convincing showing of unexpected results

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demonstrating the criticality of the claimed ratio, it would have been obvious to one of ordinary skill in the art to optimize this result-effective variable by routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1, 5 and 29-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3 and 7 of recently allowed Application No. 10/506236. Although the conflicting claims are not identical, they are not patentably distinct from each other because the applied application fails to recognize the hydrophilic properties of the fumed silica, but hydrophilicity would be provided by the fumed silica due to its inherent properties. The percentage of the surface composed of the nanoparticles is a result-effective variable affecting the function of the payload located in the nanoparticle has on the surface. Consequently, absent a clear and convincing showing of unexpected results demonstrating the criticality of the claimed ratio, it would have been obvious to one of ordinary skill in the art to optimize this result-effective variable by routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).



***Response to Arguments***

8. Applicant's arguments filed 7/1/2009 have been fully considered but they are not persuasive.

9. Applicant argues that the applied references fail to teach the use of pyrogenic (fumed) silica to form a hydrophilic surface on an article. Soane et al. is directed to fixing nanoparticles to the surface of a textile using an encapsulating carrier layer. The encapsulated "payload", in this case silica, is still active, though [0101] allowing it to perform and react according to its inherent properties. Soane et al. teach that silica will act as a sunblocking agent, however this is the case regardless of the form of silica used. A particular form of silica is not outlined by Soane et al., which is why Examiner has looked to the Handbook for guidance as to selecting a particular form of silica. The fact that Soane et al. fail to teach that the silica is hydrophilic does not preclude it from having such a property and the combination of references results in the use of fumed silica at the claimed particle size resulting in hydrophilic silica.

10. There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003) (rejecting the contention that inherent anticipation requires recognition by a person of ordinary skill in the art before the critical date and allowing expert testimony with respect to post-critical date clinical trials to show inherency); see also *Toro Co. v. Deere & Co.*, 355 F.3d 1313, 1320, 69 USPQ2d 1584, 1590 (Fed. Cir. 2004) ("[T]he fact that a characteristic is a necessary feature or result of a prior-art embodiment (that is itself sufficiently described and enabled) is enough for inherent anticipation, even if that fact was unknown at the

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time of the prior invention.”); *Abbott Labs v. Geneva Pharms., Inc.*, 182 F.3d 1315, 1319, 51 USPQ2d 1307, 1310 (Fed.Cir.1999) (“If a product that is offered for sale inherently possesses each of the limitations of the claims, then the invention is on sale, whether or not the parties to the transaction recognize that the product possesses the claimed characteristics.”); *Atlas Powder Co. v. Ireco, Inc.*, 190 F.3d 1342, 1348-49 (Fed. Cir. 1999) (“Because sufficient aeration’ was inherent in the prior art, it is irrelevant that the prior art did not recognize the key aspect of [the] invention.... An inherent structure, composition, or function is not necessarily known.”)>; *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1343-44, 74 USPQ2d 1398, 1406-07 (Fed. Cir. 2005) (holding that a prior art patent to an anhydrous form of a compound “inherently” anticipated the claimed hemihydrate form of the compound because practicing the process in the prior art to manufacture the anhydrous compound “inherently results in at least trace amounts of’ the claimed hemihydrate even if the prior art did not discuss or recognize the hemihydrate).

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW D. MATZEK whose telephone number is (571)272-2423. The examiner can normally be reached on M-F, 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571.272.1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew D Matzek/  
Examiner, Art Unit 1794